

R E M A R K S

Reconsideration of this application, as amended, is respectfully requested.

STATEMENT OF SUBSTANCE OF INTERVIEW

The Examiner is thanked for conducting a telephone interview on December 7, 2010. In the telephone interview, proposed amendments to independent claim 9 and proposed arguments for patentability were discussed. Claim 9 has been amended along the lines discussed during the telephone interview to more clearly structurally distinguish over Okibayashi.

ALLOWABLE SUBJECT MATTER

The Examiner's allowance of claims 5-8 is again respectfully acknowledged.

THE CLAIMS

Independent claim 9 has been amended to incorporate the subject matter of claim 10, and claims 10 and 12 have been canceled, without prejudice.

No new matter has been added, and it is respectfully requested that the amendments to the claims be approved and entered.

THE PRIOR ART REJECTION

Claim 9 was rejected under 35 USC 102 as being anticipated by JP 62-065485 ("Okibayashi"); and claims 10-12 were rejected under 35 USC 103 as being obvious over Okibayashi. These rejections, however, are respectfully traversed with respect to claim 9 as amended hereinabove.

The present invention relates to a paste to be applied to a desired portion of a base material for at least one of restraining fatigue crack growth in the base material and detecting fatigue crack in the base material. As recited in amended independent claim 9, the paste comprises: (i) particles having diameters of 2 μm to 40 μm , said particles comprising light-colored ceramics including white ceramics and having Vickers hardness of not less than 200 Hv; and (ii) an oil having a viscosity of 5,000 centipoises to 15,000 centipoises; wherein said particles and said oil are mixed with each other.

It is respectfully submitted that Okibayashi fails to anticipate or render obvious the above-described features of the present invention as recited in amended independent claim 9.

On page 3 of the Office Action, the Examiner acknowledges that Okibayashi is silent as to the feature of the present invention previously recited in claim 10 (and now recited in amended independent claim 9) whereby the particles include white ceramics. Nevertheless, the Examiner asserts that this feature

is an obvious modification of Okibayashi, and states that it would have been obvious to use light-colored ceramics including white ceramics in the paste of Okibayashi "so as to detect the cracks in metal." It is respectfully submitted that this rationale is not reasonable in view of the relevant fair teachings of Okibayashi.

Okibayashi discloses a coating paste that is applied to a glass substrate. See, for example, the abstract of Okibayashi (relied upon by the Examiner). It is respectfully pointed out that a glass substrate as in Okibayashi is generally hard and brittle, and therefore, a fatigue crack, such as would form in metal, would hardly grow in the brittle glass substrate of Okibayashi. Thus, it is respectfully submitted that the paste of Okibayashi relates to an entirely different field from the claimed present invention, which provides a paste to be applied to a desired portion of a base material for at least one of restraining fatigue crack growth in a base material and detecting fatigue crack in the base material.

In addition, it is respectfully pointed out that the coating paste of Okibayashi is applied to the glass substrate thereof in a stripe form or an island form, and then is subjected to a heat treatment to become a photoconductive film. Again, see the abstract of Okibayashi. And it is respectfully submitted that the coating paste of Okibayashi cannot reasonably be expected to

restrain fatigue crack growth or detect a fatigue crack in a base material as according to the claimed present invention. Still further (and significantly), it is noted that on page 2 of the Office Action, the Examiner asserts that the particles of CdSe in Okibayashi correspond to the particles of the claimed present invention. It is respectfully pointed out, however, that CdSe is a "Greenish-brown or dark red solid powder." See, for example, http://en.wikipedia.org/wiki/Cadmium_selenide. And it is respectfully submitted that one of ordinary skill would have no reason to modify the paste for forming a photoconductive film in Okibayashi by using light-colored ceramics instead of CdSe. The Examiner's suggested reason for modifying Okibayashi in this manner is "to detect the cracks in metal." However, the paste of Okibayashi is applied to a glass substrate to form a photoconductive film, and Okibayashi is completely unrelated to detecting cracks in metal.

With respect to claim 11, moreover, the Examiner acknowledges that Okibayashi fails to teach that the oil comprises silicone grease. However, the Examiner contends that this structure is an obvious modification of Okibayashi, the motivation being "to detect the cracks in metal." As explained hereinabove, however, Okibayashi is completely unrelated to detecting cracks in metal, and it would not have been obvious to turn to the paste of Okibayashi, which relates to forming a

photoconductive film, in order to detect and restrain fatigue cracks in metal as in the manner of the claimed present invention.

In this connection, the Examiner emphasizes that the "intended use" of the paste of the claimed present invention does not carry patentable weight. Nevertheless, it is respectfully submitted that, as set forth in detail above, amended claim 9 of the present application clearly structurally distinguishes over the paste disclosed by Okibayashi, which completely fails to disclose or even suggest that particles of the paste comprise light-colored ceramics including white ceramics.

Accordingly, it is respectfully submitted that Okibayashi fails to anticipate or render obvious the features of the present invention as recited in amended independent claim 9, and that amended independent claim 9 and claim 11 depending therefrom clearly patentably distinguish over Okibayashi under 35 USC 102 as well as 35 USC 103.

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Entry of this Amendment, allowance of the claims, and the passing of this application to issue are respectfully solicited.

If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned at the telephone number given below for prompt action.

Respectfully submitted,

/Douglas Holtz/

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